Remarks/Arguments

The Office Action stated: that Claims 3 and 8 to 11 are pending in this application; and that Claims 1 to 2 and 4 to 7 have been cancelled.

Claims 3, 8 and 11 have been rejected under 35 U.S.C. 102(e) as being anticipated by Duyck et al. (U.S. Published Patent Application No. 2003/0030033; the filing date of the provisional application is 12/30/1999). Applicants traverse this rejection.

The Office Action stated that the following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejection under this section made in this Office Action.

> "A person shall be entitled to a patent unless...
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the application for patent, except that an international application filed under the treaty defined in Section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

The Examiner has <u>not</u> factually proven in the record that the Duyck et al. provisional application contains all of the disclosure, namely, Example 3, in

Duyck et al. Without such continuity of disclosure, the Examiner has not proven in the record that the filing date of the Duyck et al. provisional application can be used for all of the disclosure in Duyck et al. in this Section 102(e) rejection.

The Office Action stated that Duyck et al., page 11, Example 3, [0156], anticipates the instant claimed compounds, when in the instant claims, R^3 is isopropyl, and m and n are 0. Applicants traverse this statement. The Examiner has not factually established in the record continuity of disclosure of Example 3 in Duyck et al. back to the Duyck et al. provisional application. There is no continuity of Example 3 in the disclosure going back beyond December 5, 2000 (i.e., the filing date of the Duyck et al. International Patent Application No. PCT/US00/32951).

A copy of the Duyck et al. U.S. Provisional Application No. 60/173,715 is enclosed.

Example 3 of U.S. Published Patent Application No. 2003/0030033 recites N-(4-anilinophenyl)-3-oxo N-isopropyl butanamide as the starting material. Duyck et al. is the published version of Duyck et al.'s U.S. National Stage Application No. 10/168,405 (Duyck et al. '405). Example 3 will also be in Duyck et al.'s International Patent Application No. PCT/US00/32951 (Duyck et al. PCT).

There are only two numbered examples in Duyck et al.'s Provisional Application No. 60/173,715 (Duyck et al. Provisional). Examples 1 and 2 in Duyck et al. Provisional correspond to Examples 2 and 1, respectively, in Duyck et al. [However, as explained below under the discussion of the Section 103(a) rejection, Examples 1 and 2 of Duyck et al. Provisional recite the wrong starting

material.] Duyck et al. Provisional does not contain any disclosure of the later Example 3 or N-(4-anilinophenyl)-3-oxo N-isopropyl butanamide.

Duyck et al. does not anticipate any of applicants' claims. Duyck et al. Provisional does not contain Example 3. Duyck et al. PCT has a filing date of December 5, 2000. Applicants have the earlier effective filing date of May 12, 2000 of applicants' Provisional Application No. 60/203,922. Applicants also have priority benefit of the date of February 4, 2000 of applicants' European Patent Application No. 60102418.1.

Section 102(e) does not apply because Duyck et al. does not have an effective/priority filing date before the effective/priority filing date of applicants' claimed invention.

This rejection should be withdrawn.

The Office Action stated: that applicants should amend claim 11, deleting R^1 and R^2 being hydrogen, because when m and n are 0, there is no R^1 and R^2; and that, additionally, R^1 and R^2 are no where defined as hydrogen. Claim 11 has been amended in such manner.

Claims 3 and 8 to 11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Duyck et al. Applicants traverse this rejection.

The Office Action stated that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459, (1996), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the difference between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The Patent Office policy is to follow the Graham decision including ascertaining (in the record) such four factual inquiries concerning obviousness or nonobviousness under 35 U.S.C. 103(a) [see M.P.E.P. 2141 and 2144.08]. The Supreme Court, in the Graham decision, said that there must be strict observance. The Examiner has not determined in the record all of such required factual determinations so this obviousness rejection is fatally defective on its face and no showing of prima facie obviousness has been factually (or legally) established in the record.

The Office Action stated that Duyck et al. teaches structurally similar compounds as claimed herein. The use of the so-called concept of structurally similar compounds is faulty in chemistry. Methanol is structurally similar to and is in fact a homologue of ethanol. Methanol is very toxic and fatal to humans if consumed. Ethanol consumption by humans is the basis of many human social events and is also the basis of many human social events, economic activity (bars, restaurants, advertising, etc.) and production activity. Methanol and ethanol are relatively simple molecules, yet have quite different properties as relates to consumption by humans.

The use of the so-called concept of structurally similar compounds is also faulty in law because it does not involve making the required determination of the

factual inquiries set out by the Supreme Court in the Graham decision (which the M.P.E.P. states is required by Patent Office policy). See M.P.E.P. 2144.08, II, for the requirements that an Examiner "must" do/determine factually in the record to establish a prima facie showing of obviousness and carry his/her burden of proof under Section 103(a). The Examiner has not factually established a prima facie showing of obviousness in the record.

M.P.E.P. 2144.08, II, states:

"Use of *per se* rules by Office personnel is improper for determining whether claimed subject matter would have been obvious under 35 U.S.C. 103."

The Examiner incorrectly determined the scope and content of the prior art. Duyck et al. Provisional does not contain Example 3.

The Office Action stated see, for example, compound [0114] on page 7. Applicants traverse this statement. Paragraph number 0114 in Duyck et al. does not disclose a/the "compound". Instead, paragraph number 0114 in Duyck et al. discloses a generic formula that can encompass, perhaps, millions or more of individual compounds. The generic compound has 5 variables that each have vast scope, e.g., A and B are each zero or one "alkylene", that is an open ended term. R^3 and R^4 are each hydrogen or "alkyl"; the latter is an open ended term.

Paragraph no. 0114 in Duyck et al. does not disclose any species or subgeneric groups within the generic formula set out there.

As shown below, Duyck et al. does not disclose any species or subgeneric group that has an effective U.S. filing date or priority date before the May 12,

2000 filing date of applicants' provisional application or the February 4, 2000 priority date of applicants European patent application.

The only thing that the Examiner has is a generic formula that encompasses millions or more individual compounds. The Examiner has not factually shown in the record the necessary motivation or suggestion to make applicants' claimed compounds in view of the prior art teachings of record. With such motivation missing, there is not establishment of a prima facie showing of obviousness.

M.P.E.P. 2144.08, II, states:

> "The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d, 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ('The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.')...."

The generic formula of Duyck et al. contains an enormous number of compounds, probably, millions or more.

The Office Action stated that R^2 and R^4 can be alkyl, R^5 can be diphenyl, B can be alkylene, and referred to page 4, paragraph nos. 0055, 0059 and 0061. No mention is made of A and n in such statement, yet, when n is one, A is present and is alkylene (that is an open ended term meaning that the Examiner's statement encompasses thousands or more compounds). If the Examiner meant A to be zero, the question of forbidden hindsight further arises. The Examiner

has no motivation of record to select the meanings of the variables in the Duyck et al. generic formula to try to arrive at applicants' claimed compound. As set out in the Examiner's statement, B is merely said to be alkylene, that is an open ended term encompassing a very large number of compounds. When m is zero, B is not even present, with the result that the two =O groups are on adjacent carbon atoms.

The Office Action stated, also, see compound on page 11, paragraph 0156. The Examiner is referring to Example 3, that is not present in Duyck et al. Provisional. The Examiner's reference to Example 3 is meaningless under Section 103(a), even though Section 102(e) because applicants have an effective date and a priority date before the filing date of Duyck et al. PCT.

Example 2 of Duyck et al. and Duyck et al. PCT recites N-(4-anilinophenyl)-3-oxo butanamide as the starting material. In such compound R^4 is hydrogen. Corresponding Example 1 of Duyck et al. Provisional recites N-(4-anilinophenyl)-3-amino butanamide as the starting material and the product. Therefore, the earliest date Example 2 of Duyck et al. can rely on is December 5, 2000, the filing date of Duyck et al. PCT. There is no continuity of the disclosure of Example 2 of Duyck et al. back to Duyck et al. Provisional. Applicants have the effective U.S. date of May 12, 2000 and the priority date of February 4, 2000.

Example 1 of Duyck et al. and Duyck et al. PCT recites that one of the starting materials is N-(4-anilinophenyl)-3-oxo butanamide. In such compound, R^4 is hydrogen. (The other staring material is N-(cocoalkyl)-3-aminopropanenitrile.) Corresponding Example 2 of Duyck et al. Provisional

recites N-(4-anilinophenyl)-3-amino butanamide as one of the starting materials – the other one is N-(4-cocoalkyl)-3-aminopropanenitrile. Therefore, the earliest date Example 1 of Duyck et al. can rely on is December 5, 2000, the filing date of Duyck et al. There is no continuity of the disclosure of Example 1 of Duyck et al. back to Duyck et al. Provisional.

Duyck et al. Provisional does not disclose any species where R^4 is alkyl.

The Office Action stated that it would have been prima facie obvious to one of ordinary [skill] in the art at the time the invention was made to obtain compounds within the generic disclosure of the reference because they are structurally so similar to those claimed herein, and substituents are similar to those claimed herein, with the reasonable expectation of achieving claimed compounds, absent evidence to the contrary. Applicants traverse this statement as being clearly incorrect and mere forbidden hindsight. There is no per se rule for structurally similar compounds. The generic formula of Duyck et al. encompasses a vast number of claims, probably millions or more. The size of such genus is so vast as to show the unobviousness of applicants' claimed compounds. Applicants have an effective U.S. filing date and a priority date before the date of any disclosure of any species, within or outside of the scope of applicants' claims, by the Duyck et al. line of applications. The Examiner failed to factually establish in the record a prima facie showing of obviousness. The Examiner did not factually make in the record all of the factual inquiries required by the Graham decision and Patent Office Policy. For example, there is no

factual determination of the level of ordinarily skill in the art. The Examiner still has the burden of proof.

The only use Duyck et al. discloses for the compounds in the generic formula in its paragraph no. 0156 [on page 7] is as an intermediate. Page 3, lines 15 to 20, of applicants' specification discloses that applicants' claimed compounds are useful as additives for fuels of internal combustion engines and as drying accelerators for polymers. Duyck et al. does not teach or suggest, for its intermediates, these uses and advantages of applicants' claimed compounds.

This rejection should be withdrawn.

Applicants' provisional application was in German and an English-language translation thereof was filed on May 25, 2000.

Applicants' European patent application was in German. Applicants' filed a certified copy thereof in applicants' PCT application. Applicants plan on filing a sworn English-language translation of applicants' European patent application. (Note that this translation is not necessary to overcome the anticipation and obviousness rejections.)

Applicants also plan on filing a Rule 131 declaration to establish applicants' invention of applicants' claimed compounds before the filing date of Duyck et al., Duyck et al. '405, Duyck et al. PCT and Duyck et al. Provisional. (Note that this Rule 131 declaration is not necessary to overcome the anticipation and obviousness rejections.)

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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